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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. Of: FOTLAND et al
Serial No.: 09/299,388
Filed: April 27, 1999
For: METHOD AND APPARATUS FOR PRODUCING...
Group: 1619
Examiner: R. BAWA
Docket: MICRODOSE 99.01

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The Honorable Commissioner of Patents & Trademarks
Washington, D.C. 20231

Dear Sir:

AMENDMENT A

This is in response to the Official Action mailed October 25, 2000.

Provisional election is hereby made, with traverse, to prosecute the invention of
Group I, comprising claims 1-37 and 48-71.

The restriction requirement is respectfully traversed. The Official Action
has not established a prima facie justification for the requirement for election.

In requiring restriction between inventions III and II, the Examiner takes
the position that the apparatus invention "is not an obvious apparatus for
making the product and the apparatus as claimed can be used to make a
different product, such as, spray-dried milk". Yet, neither independent claim 38,
nor dependent claims 40, 41 or 42 are material specific.

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In requiring restriction between inventions I and II, the Examiner takes the position that "the product (powder) as claimed can be made by a materially different process, such as, solvent evaporation/precipitation. Again, the Examiner appears to be misreading the claims. Neither independent claim 1 nor independent claim 48 of the group I invention specify the product as being a powder. Indeed, dependent claims 5 and 50 specify the particles as being liquid. Thus, the Examiner's reasons for requiring restriction are not well based since they ignore claim limitations.

In requiring restriction, the Examiner also notes the inventions are classified in different classes and sub-classes, thus alluding to the fact that the inventions would involve divergent fields of search. However, as the Examiner is well aware, such a factor per se is not a basis for determining distinctiveness in accordance with MPEP 806.

Furthermore, it is respectfully submitted that there is nothing in 35 USC § 121 that gives the Patent Office the authority to require restriction between different statutory classes of claims unless the claims cover "independent and distinct inventions." It is respectfully submitted that the statutory requirements, not having been met here vis-a-vis Groups I, II and III, respectively, the Examiner should withdraw the requirement for restriction and provide Applicant with an action on the merits of the withdrawn claims.

It should be noted that the restriction requirements as prescribed by 35 USC § 121 are discretionary with the Examiner, and in view of the remarks above, the restriction requirement should be withdrawn.

In summary therefore, all of the claims are believed to be directed to a single invention. However, so as to be fully responsive, Applicant provisionally elects to prosecute Group I, i.e. Claims 1-37 and 48-71, and it is requested that, without further action thereon, the remaining claims be retained in this application pending disposition of the application, and for possible rejoinder and/or for filing of a divisional application.

In reference to the third paragraph on page 3 of the action, Applicants' attorney has no record of a telephone call from the Examiner. Perhaps the Examiner called when the undersigned attorney was on the phone, or away from his desk. In any event, the Examiner does not appear to have left a message for telephone call-back. Otherwise, Applicants may have been able to respond orally.

An action on the merits is respectfully requested.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account No. 08-1391.



Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on December 7, 2000, at Manchester, New Hampshire.

By Kristine Stevens

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